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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/941,239	08/28/2001	Michael E. Sears	4000.2.57	5262
32641	7590	09/23/2005	EXAMINER	
DIGEO, INC C/O STOEL RIVES LLP 201 SOUTH MAIN STREET, SUITE 1100 ONE UTAH CENTER SALT LAKE CITY, UT 84111			LAYE, JADE O	
			ART UNIT	PAPER NUMBER
			2617	

DATE MAILED: 09/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/941,239	SEARS, MICHAEL E.	
	Examiner	Art Unit	
	Jade O. Laye	2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-64 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-64 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>1/13/03</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement (IDS) submitted on 1/13/03 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement has been considered by the examiner.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Regarding claims 12, 32, and 52, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

Art Unit: 2617

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. Claims 1-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Ejima et al* (US Pat. No. 6,259,469) in view of *Bruno et al.* (US Pat. No. 5,,710,591).

As to Claim 1, *Ejima et al* disclose a method of communicating between a video enabled and non-video enabled device comprising determining that a second device is unable to display video signals, establishing two-way audio communication, and capturing/caching video signals for subsequent display after the two-way audio communication is concluded. (Abstract; Col. 1, Ln. 28-48; Col. 2, Ln. 8-34; Col. 4, Ln. 25-28; Col. 6, Ln. 33-40; Col. 15, Ln. 31-35; Col. 18, Ln. 29-38; Col. 23, Ln. 59-62; Col. 24, Ln. 3-6; Col. 25, Ln. 1-2; Col. 27, Ln. 21-24). In order for the system to commence the communication session, it is inherent a "request" be detected. But, *Ejima* fails to specifically disclose establishing one-way communication with the first device. However, within the same field of endeavor, *Bruno et al* disclose a similar system which allows a user to establish a one-way video communication with another device. (Abstract; Fig. 1; Col. 3, Ln. 19-40; Col. 9, Ln. 23-33). This limitation is met because *Bruno* allows a user (who has a video display) to communication with a user who only has a telephone. Therefore, the user with the video display is transferring one-way video. Accordingly, it would have been obvious to one having ordinary skill in this art at the time of Applicant's invention to combine the systems of *Ejima* and *Bruno*, thereby providing a system which allows flexible audiovisual conferencing between devices with varying capabilities.

Art Unit: 2617

Claims 21, 41, and 63 correspond to Claim 1. Thus, each is analyzed and rejected as previously discussed.

As to Claim 2, *Ejima* further discloses the user of a server, which stores audio/visual data supplied by the network devices. (Col. 24, Ln. 21-24). Accordingly, the combined systems of *Ejima* and *Bruno* disclose all limitations of Claim 2.

Claims 22 and 42 correspond to Claim 2. Thus, each is analyzed and rejected as previously discussed.

As to Claim 3, *Ejima* further discloses a user is allowed to request image data from the server. (Col. 24, Ln. 21-24; Col. 27, Ln. 45-64). Accordingly, the combined systems of *Ejima* and *Bruno* disclose all limitations of Claim 3.

Claims 23 and 43 correspond to Claim 3. Thus, it is analyzed and rejected as previously discussed.

As to Claim 4, it is inherent the system of *Ejima* contain an indicator informing the system of where to locate the cached video signal within the server. If not, the system would be unable to locate the specified data among the other data within the server. Accordingly, the combined systems of *Ejima* and *Bruno* disclose all limitations of Claim 4.

Claims 24 and 44 correspond to Claim 4. Thus, each is analyzed and rejected as previously discussed.

As to Claim 5, the Examiner takes Official Notice that, at the time of Applicant's invention, the use of URL's to identify locations was well known in this art. Accordingly, it would have been obvious to one having ordinary skill in this art at the time of Applicant's

invention to further modify the combined systems of *Ejima* and *Bruno* to include URL's, thus providing a method of identifying various network locations.

Claims 25 and 45 correspond to Claim 5. Thus, each is analyzed and rejected as previously discussed.

As to Claim 6, *Bruno* further discloses that a user (i.e., telephone user) is allowed to request subsequent retrieval of indexed data. (Col. 6, Ln. 1-31). Therefore, the "indexing" is essentially a "locator link" because it allows the system to find a specified location within the stored data. Accordingly, the combined systems of *Ejima* and *Bruno* disclose all limitations of Claim 6.

Claims 26 and 46 correspond to Claim 6. Thus, each is analyzed and rejected as previously discussed.

As to Claim 7, the Examiner takes Official Notice that, at the time of Applicant's invention, the use of messaging communication networks (i.e., capable of email transmissions, etc.) was well-known in this art. Accordingly, it would have been obvious to one having ordinary skill in this art at the time of Applicant's invention to further modify the combined systems of *Ejima* and *Bruno* in order to provide a system which allows users to send email messages to one another.

Claims 27 and 47 correspond to Claim 7. Thus, each is analyzed and rejected as previously discussed.

As to Claim 8, *Ejima* further discloses the use of a terminal comprising a display screen. (Col. 2, Ln. 29-33; Col. 4, Ln. 28; Fig. 10). Accordingly, the combined systems of *Ejima* and *Bruno* disclose all limitations of Claim 8.

Claims 28 and 48 correspond to Claim 8. Thus, each is analyzed and rejected as previously discussed.

As to Claim 9, *Ejima* discloses the system is capable of transmitting stored audiovisual data between devices. (cited portions used under Claim 1 and Col. 6, Ln. 57-62; col. 8, Ln. 45-52). Accordingly, the combined systems of *Ejima* and *Bruno* disclose all limitations of Claim 9.

Claims 29 and 49 correspond to Claim 9. Thus, it is analyzed and rejected as previously discussed.

As to Claim 10, *Bruno* further discloses displaying video signals while synchronously outputting audio signals. (Col. 3, Ln. 19-40; Col. 4, Ln. 9-16). Accordingly, the combined systems of *Ejima* and *Bruno* disclose all limitations of Claim 10.

Claims 30 and 50 correspond to Claim 10. Thus, each is analyzed and rejected as previously discussed.

As to Claims 11 and 12, *Ejima* further discloses the system encodes the video signal in a compress format and stores said signal. (Col. 1, Ln. 33-40; Col. 23, Ln. 64-Col. 24, Ln. 2 and cited portions used to reject claim 1). Accordingly, the combined systems of *Ejima* and *Bruno* disclose all limitations of Claims 11 and 12.

Claims 31 and 51 correspond to Claim 11, while Claims 32 and 52 correspond to Claim 12. Thus, each is analyzed and rejected as previously discussed.

As to Claim 13, *Ejima* further discloses the use of a magnetic storage device. (Col. 29, Ln. 47-51). Accordingly, the combined systems of *Ejima* and *Bruno* disclose all limitations of Claim 13.

Claims 33 and 53 correspond to Claim 13. Thus, each is analyzed and rejected as previously discussed.

As to Claim 14, each limitation is encompassed within the rejection of Claim 1. Accordingly, the combined systems of *Ejima* and *Bruno* disclose all limitations of Claim 14.

Claims 34 and 54 correspond to Claim 14. Thus, each is analyzed and rejected as previously discussed.

As to Claims 15 and 16, *Ejima* further discloses the use of a video telephone, which could be the first or second device. (Figs. 20 and 32; Col. 24, Ln. 15-20 & cited portions used to reject Claim 1). Accordingly, the combined systems of *Ejima* and *Bruno* disclose all limitations of Claims 15 and 16.

Claims 35 and 55 correspond to Claim 15, while Claims 36 and 56 correspond to Claim 16. Thus, each is analyzed and rejected as previously discussed.

As to Claim 17, *Ejima* discloses the use of a server connected to the system. (Col. 24, Ln. 21-24). Accordingly, the combined systems of *Ejima* and *Bruno* disclose all limitations of Claim 17.

Claims 37 and 57 correspond to Claim 17. Thus, each is analyzed and rejected as previously discussed.

As to Claim 18, the use of a telephone network was disclosed under rejection of Claim 1. Accordingly, the combined systems of *Ejima* and *Bruno* disclose all limitations of Claim 18.

Claims 38 and 58 correspond to Claim 18. Thus, each is analyzed and rejected as previously discussed.

As to Claim 19, the Examiner takes Official Notice that, at the time of Applicant's invention, servers located within broadcast centers were well known in this art. Accordingly, it would have been obvious to one having ordinary skill in this art at the time of Applicant's invention to further modify the combined systems of *Ejima* and *Bruno* in order to provide a system having a server located at the broadcast center, thereby reducing the cost of having multiple hubs in the network.

Claims 39 and 59 correspond to Claim 19. Thus, each is analyzed and rejected as previously discussed.

As to Claim 20, *Ejima* further discloses the camera has a memory which stores data. (cited portions used under Claim 1). Accordingly, the combined systems of *Ejima* and *Bruno* disclose all limitations of Claim 20.

Claims 40 and 60 correspond to Claim 20. Thus, each is analyzed and rejected as previously discussed.

Claim 61 contains limitations which are encompassed within the limitations of Claims 1, 2, and 3. Moreover, *Bruno* teaches the system is capable of displaying video signals and that users are allowed to communicate with each other (i.e., interact). (also disclosed under Claim 1). Therefore, the system could be broadly interpreted as being interactive television. Accordingly, the combined systems of *Ejima* and *Bruno* disclose all limitations of Claim 61.

Claims 62 and 64 correspond to and/or are encompassed by Claim 61. Thus, each is analyzed and rejected as previously discussed.

Art Unit: 2617

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a: Remillard (US Pat. No. 5,461,667) discloses a system which integrates television with multiple external networks and devices.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jade O. Laye whose telephone number is (571) 272-7303. The examiner can normally be reached on Mon. 7:30am-4, Tues. 7:30-2, W-Fri. 7:30-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on (571) 272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Examiner: Jade O. Laye
September 19th, 2005.


NGOC-YEN VU
PRIMARY EXAMINER